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REMARKS

Claims 1-64 remain in the application. Claims 1-64 have been rejected. Claims 5, 6,

30, 32 and 49 have been amended. Applicant respectfully requests reconsideration based upon

the amendments and the following reasons.

SPECIFICATION

The Office Action objected to the specification. Applicants have made the necessary

changes.

CLAIM OBJECTIONS

The Office Action objected to claims 6 and 30 because of informalities. Accordingly,

Applicant has corrected the informalities.

CLAIM REJECTIONS UNDER 35 USC §101

Analysis of subject matter patentability begins with the statute. Section 101 provides:

> "Whoever invents or discovers any new and useful
> process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof,
> may obtain a patent therefor, subject to the conditions
> and requirements of this title."

Excluded from patent protection are laws of nature, physical phenomena, and abstract

ideas. *Diamond v. Diehr*, 450 U.S. 175 (1981). The United States Court of Appeals for the

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Federal Circuit has noted that the repetitive use of the expansive term "any" in § 101 shows Congress's intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in § 101. State Street Bank &Trust Co. v. Signature Fin. Group, 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998), cert. denied, --- U.S. ---, 119 S. Ct. 851 (1999). Moreover, the Supreme Court has acknowledged that Congress intended § 101 to extend to "anything under the sun that is made by man." Diamond v. Chakrabarty, 447 U.S. 303, 309 (1980); see also Diamond v. Diehr, 450 U.S. 175, 182 (1981). Thus, it is mproper to read limitations into § 101 on the subject matter that may be patented where the legislative history indicates that Congress clearly did not intend such limitations. See Chakrabarty, 447 U.S. at 308 ("The Federal Circuit has also cautioned that courts 'should not read into the patent laws limitations and conditions which the legislature has not expressed.'" (citations omitted)). State Street Bank & Trust Co. v. Signature Fin. Group, supra.

The Office Action has rejected claims 1, 31 and 48 under 35 USC 101 as directed to non-statutory subject matter. Applicant respectfully traverses this finding.

Claim 1 is directed to the "process" category of patentable subject matter. The burden is thus on the Examiner to establish that the invention of claim 1 fits within one of the categories of subject matter excluded from patentability. The Office Action reaches the conclusion that the claim language "using the patterns with assigned attributes to analyze the query email message" allegedly "provides no useful, concrete, and tangible result." Apart from not showing that the claimed invention falls under any of the recognized areas of non-patentability, the Office Action appears to confuse the non-statutory subject matter with the lack of utility grounds of rejection

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and cites no case authority in support of its conclusion. An invention is "useful" under 35 USC §101 "if it is capable of providing some identifiable benefit." *Juicy Whip Inc. v. Orange Bang Inc.,* 185 F.3d 1364 (Fed. Cir. 1999). The benefit must be obvious, or discovered and disclosed. *Cross v .Iizuka,* 753 F.2d 1040 (Fed. Cir. 1985). In the case of Applicant's invention, benefits are discussed at length in the Written Description and an example is the real world problem of identifying spam email (see discussion of spam in the Background section of the application). Therefore, claim 1 recites a useful benefit and is within the statutory subject matter of process.

Claim 31 relates to the machine category of patentable subject matter and the Office Action has not shown that any of the judicially recognized exceptions apply. Moreover, the Office Action has not made any showing that the claimed invention lacks utility. Therefore this rejection must be withdrawn.

Claim 48 relates to the manufacture category of patentable subject matter and the Office Action has not shown that any of the judicially recognized exceptions apply. As in the cases discussed above, the Office Action has made no showing of the applicability of any of the exceptions from patentability or lack of utility. In this case, however, the Office Action argues that the mere possibility that the claim is not limited to tangible embodiments (the specification states that the machine readable medium may be a transmission medium) renders claim 48 non-statutory. The Federal Circuit has held that a transmission medium may constitute statutory subject matter. *In re Taner,* 681 F.2d 787 (CCPA 1982). Therefore this rejection must be withdrawn.

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CLAIM REJECTIONS UNDER 35 USC §103

The Office Action has rejected claims 1, 4-21, 27-42, 47-59, and 64 under 35 USC 103(a) as being unpatentable over Rothwell et al. (US 6,769,016) in view of Kircher (US Pub No. 2003/0195937).

With respect to claims 1, 31 and 48, the Office Action concedes that Rothwell does not teach assigning attributes to the patterns. However, the Office Action contends that Kircher teaches assigning attributes to the patterns based on the annotated email messages. Applicant notes that the section of Kircher cited by the Office Action actually teaches that attributes are extracted not assigned. The Office Action concludes that the combination would have been obvious on the alleged motivation "in order to provide [sic, a] method and system to classify and to validate electronic email and messages." The Office Action reaches this conclusion without providing a shred of evidence in support. Without such evidence a rejection based on obviousness is improper because an inappropriate use of hindsight is used. The case law makes clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." Id. Ecolochem v. Southern California Edison, 227 F.3d 1361 (Fed.Cir. 2000), cert. den., 121 S.Ct. 1607 (Fed. Cir. 2000).

Claim 31 is a machine counterpart of claim 1 and claim 48 is a manufacture counterpart of claim 1. These claims distinguish patentably from the references cited for the foregoing reasons.

With respect to claim 4, the Office Action contends that Rothwell in combination with Kircher teach wherein the steps of accessing patterns and assigning attributes are carried out independently of and prior to the step of using the patterns with assigned attributes to

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analyze the query email message. Applicant respectfully traverses this conclusion. Applicant contends that the invention of claim 4 is not obvious in view of the combination of Rothwell and Kircher for the reasons that were discussed with respect to claim 1.

With respect to claims 5, 32, and 49, the Office Action contends that Rothwell in combination with Kircher teach selecting the accessed patterns that match the query email message. Kircher teaches providing the user the ability to select a category and to apply a function to each message. There is no discussion of selecting the accessed patterns that match patterns in the email message as provided in the amended claims.

With respect to claim 6, the Office Action contends that Rothwell in combination with Kircher teach storing patterns with assigned attributes in a database. Claim 6 is not rendered obvious in view of the cited combination of references for the reasons discussed with respect to claim1 from which claim 6 depends.

With respect to claims 7, 33, and 50, the Office Action contends that Rothwell in combination with Kircher teach storing patterns with assigned attributes in a database. Claims 7, 33, and 50 are not rendered obvious in view of the cited combination of references for the reasons discussed with respect to claim 1 from which claim 7 depends.

With respect to claims 7, 33, and 50, the Office Action contends that Rothwell in combination with Kircher teach storing patterns with assigned attributes in a database. Claims 7, 33, and 50 are not rendered obvious in view of the cited combination of references for the reasons discussed with respect to claim 1 from which these claims depend.

With respect to claim 8, the Office Action contends that Rothwell in combination with Kircher teach defining an attribute vector from the patterns with assigned attributes, the attribute vector characterizing the whole of the query email message. Claim 8 requires that the attribute vector characterizes the whole of the query email message. The part of Kircher cited by the Office Action says nothing about the whole of the email message. The Office Action appears to presume that steps 86a − 86k represent the whole of the email message but the Kircher reference does not say that.

With respect to claims 9, 34, and 51, the Office Action contends that Rothwell in

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combination with Kircher teach wherein one or more of said annotated email messages comprises an unwelcome email message. Claims 9, 34, and 51 are not rendered obvious in view of the cited combination of references for the reasons discussed with respect to claim1 from which claim 9 depends.

With respect to claim 10, the Office Action contends that Rothwell in combination with Kircher teach storing the patterns with assigned attributes in a database serving as a "SPAM-dictionary." Claim 10 is not rendered obvious in view of the cited combination of references for the reasons discussed with respect to claim1 from which claim 10 depends.

With respect to claims 11, 35, and 52, the Office Action contends that Rothwell in combination with Kircher teach wherein one or more of said annotated email messages comprises a welcome email message. Claims 11, 35, and 52 are not rendered obvious in view of the cited combination of references for the reasons discussed with respect to claims 1, 31, and 48 from which these claims depend.

With respect to claim 12, the Office Action contends that Rothwell in combination with Kircher teach storing the patterns with assigned attributes in a database serving as a "SPAM-dictionary." Claim 12 is not rendered obvious in view of the cited combination of references for the reasons discussed with respect to claim1 from which claim 12 depends.

With respect to claims 13, 36, and 53, the Office Action contends that Rothwell in combination with Kircher teach wherein said database comprises (i) a first subdatabase comprising annotated unwelcome email messages ("SPAM"), and (ii) a second subdatabase comprising annotated welcome email messages ("non-SPAM"). Claims 13, 36, and 53 are not rendered obvious in view of the cited combination of references for the reasons discussed with respect to claims 1, 31, and 48 from which these claims depend.

With respect to claims 14, 37, and 54, the Office Action contends that Rothwell in combination with Kircher teach wherein said database comprises (i) a first subdatabase comprising annotated unwelcome email messages ("SPAM"), and (ii) a second subdatabase comprising annotated welcome email messages ("non-SPAM"). Claims 14, 37, and 54 are not rendered obvious in view of the cited combination of references for the reasons discussed with

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respect to claims 1, 31, and 48 from which these claims depend.

With respect to claims 15, 38, and 55 the Office Action contends that Rothwell in combination with Kircher teach wherein the query email message comprises characters of a human language and the number of counters is proportional to the number of said characters in the query email message. Claims 15, 38, and 55 are not rendered obvious in view of the cited combination of references for the reasons discussed with respect to claims 1, 31, and 48 from which these claims depend.

With respect to claims 16, 39, and 56 the Office Action contends that Rothwell in combination with Kircher teach wherein the assigned attributes are used to contribute values to counters of the attribute vector corresponding to portions of the query email message matched by the patterns. Claims 16, 39, and 56 are not rendered obvious in view of the cited combination of references for the reasons discussed with respect to claims 1, 31, and 48 from which these claims depend.

With respect to claims 17, 40, and 57 the Office Action contends that Rothwell in combination with Kircher teach a plurality of attribute vectors. Claims 17, 40, and 57 are not rendered obvious in view of the cited combination of references for the reasons discussed with respect to claims 1, 31, and 48 from which these claims depend.

With respect to claim 18, the Office Action contends that Rothwell in combination with Kircher teach wherein the values contributed to the counters of each of the attribute vectors of the plurality of attribute vectors are normalized. Claim 18 is not rendered obvious in view of the cited combination of references for the reasons discussed with respect to claim1 from which claim 12 depends.

With respect to claims 19, 41, and 58, the Office Action contends that Rothwell in combination with Kircher teach wherein each attribute vector of the plurality of attribute vectors represents a different attribute. Claims 19, 41, and 58 are not rendered obvious in view of the cited combination of references for the reasons discussed with respect to claims 1, 31, and 48 from which these claims depend.

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With respect to claims 20, 42 and 59, the Office Action contends that Rothwell in combination with Kircher teach this limitation. Claims 20, 42, and 59 are not rendered obvious in view of the cited combination of references because the cited combination does not disclose ordering or ranking of the attribute vectors.

With respect to claim 21, the Office Action contends that Rothwell in combination with Kircher teach wherein only highly ranking attribute vectors are kept.   Claim 21 is not rendered obvious in view of the cited combination of references for the reasons discussed with respect to claim 20 from which claim 12 depends.

With respect to claims 27, 47 and 64, the Office Action contends that Rothwell in combination with Kircher teach further comprising the step of determining a score for the patterns with assigned attributes used to contribute to the attribute vector, said database comprising (i) a first subdatabase comprising annotated unwelcome email messages ("SPAM"), and (ii) a second subdatabase comprising annotated welcome email messages ("non-SPAM"), said score representing a degree of similarity, between the query email message and at least one of said annotated unwelcome email messages ("SPAM"), and a degree of dissimilarity between the query email message and at least one of said annotated welcome email messages ("non-SPAM"). Claims 27, 47 and 64 are not rendered obvious in view of the cited combination of references because the cited combination does not disclose the above limitations. The archive discussed at Rothwell. Col. 6, line 17 is not the same as the claimed database which includes subdatabases.

With respect to claim 28, the Office Action contends that Rothwell in combination with Kircher teach the step of defining, for each of said assigned attributes, a value criterion based on the value of the counters of the attribute vector to determine whether the corresponding attribute is present in the query email message.   Claim 28 is not rendered obvious in view of the cited combination of references because the cited references do not teach or suggest a value criterion as claimed.

With respect to claim 29, the Office Action contends that Rothwell in combination with Kircher teach the step of defining, for each of said assigned attributes, a value criterion

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based on the value of the counters of the attribute vector to determine whether the corresponding attribute is present in the query email message. Claim 29 is not rendered obvious in view of the cited combination of references because of the reasons discussed with respect to claim 27 on which claim 29 depends.

With respect to claim 30, the Office Action contends that Rothwell in combination with Kircher teach the step of defining, for each of said assigned attributes, a value criterion based on the value of the counters of the attribute vector to determine whether the corresponding attribute is present in the query email message. Claim 30 is not rendered obvious in view of the cited combination of references because of the reasons discussed with respect to claim 27 on which claim 30 depends.

With respect to claims 2-3 the Office Action concedes that the Rothwell-Kircher combination does not teach use of the Teiresias pattern recognition algorithm. However, it alleges that US Patent no. 6,446,011 to Floratos teaches this limitation. Applicant submits that Floratos is not prior art to applicant's application because Floratos was, at the time the claimed invention was made, assigned to the same assignee as the claimed invention, International Business Machines Corporation. 35 USC 103(c) states: "(c)(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person."
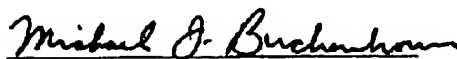
With respect to claims 22-26, 43-46 and 60-63, the Office Action concedes that Rothwell in combination with Kircher do not teach determining a score for the patterns with assigned attributes used to contribute to the attribute vector but alleges that US Patent Application Publication US2005/0081059 teaches this limitation. The Office Action further contends that it would have been obvious to make the above combination "in order to provide an enhancement to the current method and system ..." Office Action at page 11. "When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." In re Rouffet, 149 F.3d 1350, 1355, 47

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USPQ2d 1453, 1456 (Fed. Cir. 1998) (citing <u>In re Geiger</u>, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)). The same principle applies to invalidation. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." <u>ACS Hosp. Sys., Inc. v. Montefiore Hosp.</u>, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). The showing must be clear and particular. Broad conclusory statements regarding the teaching of multiple references standing alone are not evidence. In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1998). In the instant case the showing for the motivation is not clear or specific and therefore the rejection is improper because of an improper use of hindsight.

For the foregoing reasons, Applicant respectfully requests allowance of the pending claims.

Respectfully submitted,

Michael J. Buchenhorner

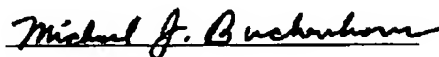Michael J. Buchenhorner
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Date: <u>January 8, 2007</u>

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Certificate of Facsimile Transmission

I hereby certify that this Amendment and Response to Office Action, and any documents referred to as attached therein are being facsimile transmitted on this date, **January 8, 2007**, to fax number 571 273-8300.

Michael J. Buchenhorner

Michael J. Buchenhorner

Date: January 8, 2007

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